

REMARKS/ARGUMENTS

Election of Inventions

The Examiner has required the election of a single invention for prosecution on the merits. The Examiner has identified the following inventions:

Group I: Claims 1-7 and 15-50, drawn to a method for producing an improved cold band;

Group II: Claims 8-14 and 51-79, drawn to a cold band.

The Examiner's position is that the inventions do not relate to a single general inventive concept under PCT Rule 13.1 because they do not share all the technical features of the method of Group I. The Examiner states that Group I allows the coating of the band before or after the annealing step while Group II requires annealing of a previously coated band. While the applicants traverse the restriction requirement, they recognize the requirement to elect an invention for prosecution, and affirm the previous provisional election of the claims of Group I.

While the Examiner has issued a restriction requirement in this case, the Examiner has cited PCT Rule 13 for support, which governs unity of invention in an international application or a national phase of an international application rather than restriction practice standards. The Applicants' traversal will address the rationale under Rule 13 as cited by the Examiner. The Applicants traverse the Examiner's restriction requirement because the two groups of claims are related as claims for a given product and claims for a process specially adapted for the manufacture of that product. Such claims are properly permitted in a single application under PCT Rule 13 (MPEP, Appendix AI, Annex B, Part 1(e)). Furthermore, in light of the amendment herein, in which claim 1 has been amended to recite that a coating step precedes the annealing step, it is maintained that the Examiner's rationale for the restriction requirement is now moot. Rejoinder of the non-elected claims of Group II is requested.

Claims 1, 2, 4, 5, 15, 18, 33, and 34 stand rejected. Claims 3, 6, 7, 16, 17, 19-32, and 35-50 were objected to as being dependent on a rejected base claim, but the Examiner indicated they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim.

In light of the Examiner's statement regarding claims 3, 6, 7, 16, 17, 19-32, and 35-50, claim 1 has been amended to include the limitations of claim 3, which previously depended directly from claim 1. Claims 2 and 3 have been cancelled without prejudice or disclaimer as to the subject matter contained therein. Independent claim 1, as currently amended, now contains all the limitations of previously considered claim 3. Independent claims 80 and 81, which contain all the limitations of claims 6 and 7, respectively, as considered to be allowable in the previous office action, have been added. Therefore, the Applicants maintain that independent claims 1, 80 and 81, patentably distinguish over the cited prior art. Likewise, claims 4-7 and 15-50, which depend from and incorporate all the limitations of claim 1, also patentably distinguish over the cited prior art.

The outstanding Office action was mailed on 23 November 2004. The Examiner set a shortened statutory period for reply of 3 months from the mailing date. Therefore, this response is timely if filed before 23 February 2005. No petition for an extension of time or accompanying fee is believed to be due in making this response. In this response, claims 2 and 3 have been cancelled and new claims 80 and 81 have been added. As a result, no additional claim fees are believed to be due. However, in the event that a fee for the filing of his response is insufficient, the Commissioner is authorized to charge any fee deficiency or to credit any overpayment to Deposit Account 15-0450.

Respectfully submitted,



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